

**REMARKS**

Claims 1-37 are pending. Claims 1, 3, 9, 10, 11, 22, 25, 31, 32 and 33 are amended. No new matter has been added as a result of the amendments. Claims 7, 23 and 29 are canceled.

**RESPONSE TO REJECTION UNDER 35 U.S.C. § 112**

Claims 3, 9, 11, 25, 31 and 33 are rejected as indefinite. Applicants have amended the relevant claims and believe that the amended claims overcome the rejection.

**RESPONSE TO REJECTION UNDER 35 U.S.C. § 102/103(a)**

The pending claims are rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Klayder et al. (hereinafter "Klayder"). The pending claims are also rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Merrifield et al. (hereinafter "Merrifield"). The pending claims are further rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Estes (hereinafter "Estes"). The pending claims are also rejected under 35 U.S.C. 103(a) as obvious over Estes in view of Zhou et al. (hereinafter "Zhou").

Under the patent statute, a patent claim is invalid if the claimed invention is anticipated by a prior art reference under 35 U.S.C. § 102. The Federal Circuit has held that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Spada*, 911 F.2d 705, 15 U.S.P.Q.2d 1655 (Fed. Cir. 1990); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 7 U.S.P.Q.2d 1315 (Fed. Cir. 1988); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986). For anticipation, **there must be no difference between the claimed invention and the reference disclosure**, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1665, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991) (emphasis added).

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), **three basic criteria** must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) when combined must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

#### **A Motivation to Combine Must Be Shown**

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). A mere conclusory statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). The Federal Circuit in *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001), noted that "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art. *Id.* at 1697. In other words, *In re Zurko* expressly proscribes any reliance by an examiner on what constitutes the knowledge of one skilled in the art, when the assessment of that knowledge is not based on any evidence in the record. More recently, the Federal Circuit reiterated this position in *In re Lee*, where it took issue with the fact that "neither the examiner nor the Board adequately supported the selection and combination of the ... references to render obvious that which [patentee] described." *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

If a proposed modification would render the prior art teaching being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

**There Must Be a Reasonable Expectation of Success**

The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986). Evidence showing that there is no reasonable expectation of success supports a finding of nonobviousness. *In re Rinehart*, 531 F.2d 1048 (C.C.P.A. 1976).

**All Claim Limitations Must Be Taught or Suggested**

To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). In other words, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970). If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent claim 1 and its dependent claims are directed to a tire dressing composition, comprising a silicone microemulsion and a wetting agent, wherein the wetting agent is selected from the group consisting of nonionic polymeric fluorochemical wetting agents, anionic phosphate fluorosurfactants, anionic lithium carboxylate fluorosurfactants, nonionic ethoxylated fluorosurfactants, polyether modified polydimethylsiloxane wetting agents, polyalkyleneoxide modified heptamethyltrisiloxane wetting agents, and organomodified polysiloxane blend wetting agents. Independent claim 22 and its dependent claims are directed to methods of forming a durable, shiny, water repellant coating on a tire, comprising the step of applying a tire-dressing composition to a surface of a tire, the tire-dressing composition comprising a silicone microemulsion and a wetting agent, wherein the wetting agent is selected from the group consisting of nonionic polymeric fluorochemical wetting agents, anionic phosphate fluorosurfactants, anionic lithium carboxylate fluorosurfactants, nonionic ethoxylated fluorosurfactants, polyether modified polydimethylsiloxane wetting agents, polyalkyleneoxide modified heptamethyltrisiloxane wetting agents, and organomodified polysiloxane blend wetting agents.

Klayder- According to the Examiner, Klayder teaches silicone gels. Examiner specifically points to Example 2 stating that the composition “contains a silicone microemulsion and a

polyalkylene oxide modified silicone surfactant.” Office Action at p. 2, ¶ 6. Example 2 in Klayder is directed to a silicone gel wax containing a silicone surfactant (polyalkylene oxide-modified polydimethylenesiloxane) and an amino-functional silicone. According to the Examiner, the polyalkylene oxide-modified polydimethylenesiloxane meets the limitations of the claimed wetting agent recited in original claim 7. Applicants respectfully disagree with this statement because original claim 7 specifically recites polyalkyleneoxide modified heptamethyltrisiloxane wetting agents, **and not** polyalkylene oxide modified silicone surfactants in general. On the other hand, Klayder recites a polyalkylene oxide-modified polydimethylenesiloxane. It is important to note that heptamethyltrisiloxane is not the same as polydimethylenesiloxane. Because the polyalkylene oxide-modified polydimethylenesiloxane in Klayder does not meet the limitations of the claimed wetting agent, Klayder does not anticipate independent claims 1 and 22, as amended, or their dependent claims.

In addition, Klayder does not render the claims unpatentable under 35 U.S.C. § 103 because the reference does not teach or disclose all of the claim limitations and a *prima facie* case of obviousness cannot be established.

Merrifield- Merrifield discloses a microemulsion formed by blending an amino-functional polyorganosiloxane and a surfactant. However, amended claim 1 recites a specific list of surfactants, none of which are disclosed in Merrifield. Because the surfactant in Merrifield does not meet the limitations of the claimed wetting agent, Merrifield does not anticipate independent claims 1 and 22, as amended, or their dependent claims.

In addition, Merrifield does not render the claims unpatentable under 35 U.S.C. § 103 because the reference does not teach or disclose all of the claim limitations and a *prima facie* case of obviousness cannot be established.

Estes- Estes discloses a rubber or vinyl surface protectant composed of a silicone component and a surfactant. However, amended claim 1 recites a specific list of surfactants, none of which are disclosed in Estes. Because the surfactant in Estes does not meet the limitations of the claimed wetting agent, Merrifield does not anticipate independent claims 1 and 22, as amended, or their dependent claims.

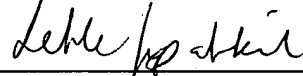
In addition, Estes does not render the claims unpatentable under 35 U.S.C. § 103 because the reference does not teach or disclose all of the claim limitations and a *prima facie* case of obviousness cannot be established.

Estes in view of Zhou- The combination of Zhou and Estes does not cure the defects in the Estes as set forth above. Furthermore, the Examiner has not provided a motivation to combine the Estes and Zhou references as required by 35 U.S.C. § 103 and Federal Circuit precedent.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: Dec 28, 2004

Respectfully submitted,

By 

Lekha Gopalakrishnan

Registration No.: 46,733

Margaret A. Boulware

Registration No.: 28,708

JENKENS & GILCHRIST, A PROFESSIONAL  
CORPORATION

5 Houston Center

1401 McKinney, Suite 2700

Houston, Texas 77010

(713) 951-3300

Attorneys For Applicant